

REMARKS**INTRODUCTION:**

In accordance with the foregoing, claims 1-21 and 28-29 have been retained in their present form. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-21 and 28-29 are pending. Claims 22-24 and 26 are withdrawn. Reconsideration is respectfully requested.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response and Request for Reconsideration because:

The arguments set forth below set forth a basis for allowance of claims 1-21 and 28-29.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at pages 2-6, numbered paragraphs 3-21, claims 1-21 and 28-29 were rejected under 35 U.S.C. §103 as being unpatentable over Oohchida et al. (USPN 6,584,060; hereafter, Oohchida) in view of Inada et al. (JPO Patent Application JP 60-257584; hereafter, Inada). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

It is respectfully submitted that the present claimed invention, as set forth in independent claims 1, 12, 28 and 29, discloses two different photodetectors, a monitoring photodetector and a signal detecting photodetector. As recited in paragraph [0034] of the specification, "A portion of light emitted from the light source 10 travels toward a disc 25 after passing through the effective aperture of the grating 13, and the remainder of the light is reflected from the reflecting member 15 and incident on the monitoring photodetector 12. Power of recording light for recording information on the disc 25 is controlled using a signal detected by

the monitoring photodetector 12." (emphasis added)

As recited in paragraphs [0038]-[0039], recited below for the convenience of the Examiner, focusing servo and tracking servo operations are performed using a light signal focused on a signal detecting photodetector:

[0038] Light passed through the grating 13 is reflected from the optical path changer 17, passes through the collimating lens 20 and the objective lens 23, and is condensed on the disc 25 so that information is recorded on the disc 25. Next, light reflected from the disc 25 passes through the objective lens 23, the collimating lens 20, and the optical path changer 17, and is focused on a signal detecting photodetector 30. (emphasis added)

[0039] Focusing servo and tracking servo operations are performed using a light signal focused on a signal detecting photodetector 30. At this time, even if a portion of the light incident on the signal detecting photodetector 30 is reflected, the reflected light is not incident on the monitoring photodetector 11. (emphasis added)

Hence, the signal detecting photodetector of the present invention does not enable the monitoring photodetector to accurately determine a power of recording light, but instead receives light reflected from the disc and utilizes said light for focusing servo and tracking servo operations. Thus, the signal detecting photodetector of the present invention does not control the monitoring photodetector, as would be the case if Oohchida and Inada were to be combined. Hence, the combination of Oohchida and Inada teaches away from the present claimed invention.

As recited in claim 1, the present claimed invention utilizes two separate photodetectors that have separate functions, and which utilize light reflected from the reflecting member to determine power of recording light and to receive light reflected from the disc, respectively. In contrast, Oohchida recites a single photodetector unit for detecting the diffracted returning light beam that is reflected by the reflective optical surface. Inada recites a photodetector for keeping a light output at a specific level, wherein a semiconductor laser with a built-in photodetector eliminates a problem that the ratio of the front surface light and the back surface light changes when the light coming out of from a resonance surface is partially returned to the resonator so that the output from the front surface light cannot be controlled by the back surface light.

On page 3 of the Office Action, the Examiner submits: "One of ordinary skill in the art at the time of the invention would have realized that the system of Oohchida would have been sensitive to noise when monitoring the reflected light from the disc and ratio of reflected light to original light will be different and some mechanism to reduce this noise could be necessary to improve the quality of the signal" (emphasis added). It is respectfully submitted that there is no

teaching or suggestion that a ratio of reflected light to original light will be different so that combination of Oohchida with Inada is needed. Nowhere does Oohchida suggest that the system of Oohchida would be sensitive to noise to that some mechanism to reduce this noise could be necessary. It is also respectfully submitted that Inada (published December 19, 1985) was known to those skilled in the art at the time Oohchida was filed (June 24, 1999) and when the foreign priority document of Oohchida was filed (June 24, 2998). Inada does not teach or suggest combination with Oohchida, which had not yet been filed when Inada was published. Oohchida does not teach or suggest combination of the elements of Inada with Oohchida. The Examiner simply states that it would be obvious to combine Oohchida and Inada. Such a statement does not represent motivation or suggestion. Had it been obvious to one skilled in the art to combine Oohchida with Inada at the time Oohchida was filed, Oohchida would have done so. There is no indication that Oohchida considered such a combination.

It is respectfully submitted that the Examiner is using hindsight to provide a blueprint of the present invention. In Ruiz and Foundation v. A.B. Chance Company, 69 USPQ2d 1690 (CAFC January 29, 2004), the court held:

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Env'tl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. See In re Rouffet, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

It is respectfully submitted that the Examiner is providing no motivation or suggestion of combining Oohchida and Inada to obtain the present claimed invention.

Hence, it is respectfully submitted that independent claims 1, 12, 28 and 29 are patentable under 35 U.S.C. §103 over Oohchida et al. (USPN 6,584,060) in view of Inada et al. (JPO Patent Application JP 60-257584). Since claims 2-11 and 13-21 depend from claims 1 and 12, respectively, claims 2-11 and 13-21 are patentable under 35 U.S.C. §103 over Oohchida et al. (USPN 6,584,060) in view of Inada et al. (JPO Patent Application JP 60-257584) for at least

the reasons claims 1 and 12 are patentable under 35 U.S.C. §103 over Oohchida et al. (USPN 6,584,060) in view of Inada et al. (JPO Patent Application JP 60-257584).

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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